

R E M A R K S

- Claims 34 – 45, 50, and 51 are currently pending in the Application.
- Claims 34 – 37, 39, 42, 44, 45, 50 and 51 have been amended herein as follows:
 - claims 34, 50, and 51 have been amended to make explicit what was inherent in the claims, the feature that requests for a diagnosis are transmitted “electronically”
 - claim 35 has been amended to correct an inadvertent typographical error noted in a review of the claims
 - claims 34, 36, 37, 39, 50, and 51 have been amended to correct an improper antecedent basis noted during a review of the claims: the term “*amount*” of *diagnoses* has been corrected to be a “*number*” of *diagnoses*, as the term is introduced in a preceding feature of each respective claim
 - claim 42 has been amended to make explicit that the entity that continuously monitors physiological parameters is different from an expert who provides an opinion on which a diagnosis is based
 - claims 44 and 45 have each been amended to refer to claim 43 as the parent claim, rather than claim 42, thus correcting a lack of antecedent basis for the term “action” and “instruction”, respectively
- Claims 52 and 53 have been added as a new independent claim. Claims 52 and 53 are each fully supported by the specification as filed and are each patentable over the prior art at least for the same reasons as discussed below with respect to claims 34, 50, and 51.

1. Personal Interview

Applicants thank Examiner Gilligan and Examiner Thomas for extending the courtesy of a personal interview on March 31, 2003 and for the helpful and thorough discussion of the prior art. Discussed during the interview were the differences in the agreement taught by U.S. Patent No. 6,324,516 B1 to Shults et al. (“Shults” herein) and the agreement claimed in pending claim 34. In particular, Applicants argued that Shults does not teach or suggest an agreement to provide a “diagnosis”, much less a “minimum number of diagnoses”. Rather, Applicants argued, Shults teaches a cost containment system that involves an agreement by a doctor to provide “no more than a *maximum* number of *treatments*”. As will be discussed in more detail below, a person of ordinary skill in the art, upon reading Shults, would not have been taught or recognized an agreement to provide a “*minimum* number of *treatments*” (since the goal of Shults is to keep costs down and thus the number of treatments down and to avoid encouraging excess treatments), much less a “*minimum* number of *diagnoses*”. Applicants gratefully acknowledge Examiners’ agreement that a “treatment” is significantly different from a “diagnosis”. Applicants also gratefully acknowledge Examiners’ agreement to reconsider the art in light of Applicants’ arguments.

Also discussed during the interview was the step of “transmitting” in claim 34, and Examiners’ concern that the step may read on a patient’s verbal request for a diagnosis.

Applicants have amended claims 34, 50, and 51, per Examiners' request, to recite that "transmitting" a request, in the embodiments encompassed by claims 34 – 45, 50, and 51, is performed electronically.

2. Section 101 Rejection

Claims 34 – 41 and 51 stand rejected under 35 U.S.C. §101 because "the claimed invention is directed to non-statutory subject matter". Applicants respectfully traverse this rejection.

No proper basis for §101 rejection provided

Applicants are unaware of any statutory (e.g., as interpreted in case law) or regulatory authority for the following two-prong test, utilized by Examiner as the basis for the §101 rejection:

- (i) whether the invention is within the technological arts; and
- (ii) whether the invention produces a useful, concrete, and tangible result.

The Federal Circuit has made it clear that there is a test for determining whether a claimed invention is directed to statutory subject matter under §101. That test is whether the claimed invention produces a "useful, concrete, and tangible result" and does not involve any additional inquiries (e.g., "technological arts" inquiry). *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). The **only issue** is whether the claimed invention produces a useful, concrete, tangible result. The claim in that case was held statutory because it produced "a useful, concrete, tangible result":

The PIC indicator represents information about the call recipient's PIC, **a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC's subscriber**. Because the claimed process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of § 101. *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999) (emphasis added)

See also MPEP 2106 (IV)(B)(2)(b)(ii) "Computer-Related Processes Limited to a Practical Application in the Technological Arts" (page 2100-15 of MPEP 7th Edition, Rev. 1, Feb. 2000).

"A claim is limited to a practical application when the method, as claimed, produces a **concrete, tangible and useful result**; i.e., the method recites a step or act of producing something that is **concrete, tangible and useful**.

Likewise, a machine claim is statutory when the machine, as claimed, produces a **concrete, tangible and useful result**."

The presently pending claims produce the useful, concrete and tangible results of, e.g., causing a compensation amount to be provided to an expert (claim 34, 50, and 51), or receiving a diagnosis (claim 42).

It is a misunderstanding of Federal Circuit case law to contend that processes claims lacking physical limitations, which appears to Applicants to be the underlying basis for the first prong of the test set out by Examiner, are not patentable subject matter. *AT & T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). This type of physical limitations analysis is of little value because "the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a 'useful, concrete and tangible result.'" *Id.*

Applicants agree that a claimed invention, to be patentable, must be within the technological arts and that mere ideas in the abstract are not patentable subject matter. However, Applicants disagree that the claimed invention is directed to a mere idea in the abstract. The claimed invention is a process that produces a "useful, concrete, and tangible result" and thus meets the test of the Federal Circuit to determine whether an invention is directed to statutory subject matter under §101 and not a mere abstract idea. Applicants gratefully acknowledge Examiner's agreement pg. 3, ¶ 6 of paper no. 6) that the claims recite a process that produces a useful, concrete, and tangible result.

Regarding the "within the technological arts" prong of the test set out by Examiner, Applicants respectfully request that Examiner provide a statutory, regulatory, or case law basis for this prong of the test utilized by Examiner, so that Applicants may properly review the claims in light of the test set out by that authority. It is unclear Applicants, in view of the Federal Circuit interpretations of §101, as to how or why the pending claims need be amended in order to be directed to patentable subject matter. It is further unclear to Applicants what is meant by the term "technological arts". It appears that amending the claims to recite a "structure or functionality to suggest that a computer performs the recited steps", in an element of the claim and not merely in the preamble, is a suggestion provided by Examiner that would overcome the §101 rejection of the claims. (pg. 3, ¶ 7 of paper no. 6). However, as discussed above, Applicants are not aware of any authority that would require such an amendment and, again, respectfully request that Examiner provide a basis of authority for the rejection.

Applicants are concerned that the "technological arts" prong of the test may improperly be based on a concern that the claimed process may be performed without the aid of a computer or other device (e.g., is a mental process). Applicants agree that the claimed method does not require that any or all of the steps recited therein be implemented on a computing device or other apparatus, although they certainly can be in accordance with some disclosed embodiments of the present invention. However, the mere fact that some or all of the steps of a

method "may be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think" does not render a sequence of operational steps non-statutory under 35 U.S.C. §101. *In Re Musgrave*, 57 C.C.P.A. 1352, 431 F.2d 882 (C.C.P.A. 1970). The court, in *Musgrave*, rejected the PTO's reasoning that the claims at issue were non-statutory under 35 U.S.C. §101 merely because they" include no physical steps but set forth merely a method for processing data which does not require any tangible device or apparatus to carry out the method and hence could be carried out mentally." The court, in *Musgrave*, reiterated its holding in an earlier case, that "patent protection for a process disclosed as being a sequence or combination of steps, capable of performance without human intervention...is not precluded by the mere fact that the process could alternatively be carried out by mental steps." *In Re Prater*, 56 C.C.P.A. 1376, 415 F.2d 1378 (C.C.P.A. 1968). *See also In Re Toma*, where the court stated that an analysis of whether a claimed process involved mental steps had no bearing on an analysis of whether the claimed process was directed to statutory subject matter under §101. *In re Toma*, 575 F.2d 872, 197 U.S.P.Q. 852 (C.C.P.A. 1978).

In conclusion, Applicants respectfully request that the §101 rejection be withdrawn. Alternatively, if Examiner maintains the rejection, Applicants respectfully request that Examiner provide Applicants with a proper statutory (e.g., as interpreted in case law) or regulatory basis for the rejection.

3. Section 112 Rejection

Claims 44 and 45 stand rejected under 35 U.S.C. §112, second paragraph. Specifically, Examiner points out that there is insufficient basis for the term "the action to be taken" in claim 44 and for the term "the at least one instruction" in claim 45. Claims 44 and 45 have each been amended to depend from claim 43 rather than from claim 42. Thus, there is now sufficient antecedent basis for each respective term noted above. Applicants respectfully submit that this rejection is now moot.

4. Section 102 Rejection

Claims 42 – 45 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,046,761 to Echerer ("Echerer" herein). Applicants respectfully traverse this rejection. The following claimed feature, particularly the aspects emphasized, are not taught or suggested by Echerer:

- receiving a diagnosis based on the anomaly, the diagnosis being based on an opinion of at least one expert contacted by the entity in response to a detection of the anomaly

In the one or more embodiments of Applicants' invention claimed in claim 42, a person wears at least one telemetry device via which an entity monitors physiological parameters

of the person. The person may receive an indication that an anomaly has occurred in at least one of the physiological parameters and a diagnosis based on the anomaly. The diagnosis is based on an opinion of at least one expert contacted by the entity in response to a detection of the anomaly. Claim 42 has been amended herein to make explicit what was an inherent in the claim before the amendment: that the entity that continuously monitors the physiological parameters is not the expert who provides the opinion and that the expert is contacted in response to an anomaly in at least one physiological parameter being detected. Such a feature is not taught or suggested by Echerer, which teaches a "station" in a remote location that a patient may use to communicate with a doctor or other medical personnel located at a second, central station. No entity, different from the doctor who communicates with the patient, is involved in continuously monitoring any physiological parameters in Echerer. An advantage of the one or more embodiments encompassed by claim 42 is that a monitoring system is "able to analyze a signal from remote monitoring equipment, e.g., medical monitoring equipment, in such a way as to make a preliminary decision about whether or not an expert, such as a physician, should be contacted..." (pg. 2, lines 10 – 13 of specification).

Echerer also does not teach or suggest "continuously" monitoring one or more physiological parameters of a person, as is claimed in claim 42. Nor does Echerer teach or suggest "wearing the at least one telemetry device" as is claimed in claim 42. Rather, Echerer teaches a system where a patient may visit a location of a station that the patient may use to transmit an indication of a physiological measurement to a remote doctor. This monitoring is only for the duration of the communication with the doctor, or a portion thereof, and is therefore not "continuous".

Claims 43 – 45 are each respectively dependent on claim 42 and are thus patentable at least for the same reasons as discussed with respect to claim 42.

Additionally, claim 44 teaches the following feature that is not taught or suggested by Echerer:

- a diagnosis includes at least an instruction regarding an action to be taken by the entity in accordance with the diagnosis.

As discussed above, Echerer does not teach or suggest involvement of an entity besides the doctor or other medical personnel that may be communicating with the patient from the remote, central, station. Accordingly, Echerer cannot teach or suggest that a diagnosis includes an instruction regarding an action to be taken by the entity.

Applicants respectfully submit that claims 42 – 45 are patentable over Echerer and request that the rejection of these claims be withdrawn.

5. Section 103 Rejection

Claims 34 – 41, 50, and 51 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,845,255 to Mayaud ("Mayaud" herein) in view of U.S.

Patent No. 6,324,516 to Shults et al. ("Shults" herein). Applicants respectfully traverse this rejection.

The suggested combination of prior art does not teach or suggest each of the limitations of the pending claims. In particular, neither Shults nor Mayaud, alone or in combination, teach or suggest the following features, which are each generally recited in each of independent claims 34, 50, and 51:

- (i) an agreement wherein an expert (e.g., doctor) agrees, in exchange for a periodic compensation amount, to provide a minimum number of diagnoses during a time period;

- (ii) transmitting, electronically and during the time period, a plurality of requests to the expert, each request comprising a request for a diagnosis of a physical anomaly associated with a patient

In an example of one or more embodiments encompassed by claims 34, 50, and 51, a doctor may earn extra cash (e.g., \$500 per month) by agreeing to provide to a system at least ten diagnoses per month. For example, from time to time (e.g., when the system detects an anomaly in a physiological parameter of a patient being monitored by the system) the system may electronically (e.g., via a pager or cellular telephone) contact the doctor with a request for a diagnosis of the anomaly. If the doctor accepts at least 10 such requests in a given month and provides the at least 10 diagnoses, each respectively corresponding to an accepted request, the doctor is provided at the end of the month with the \$500 specified by the agreement. Such an embodiment is not described or suggested by any of the prior art of record, as will be clear upon reading the discussion below. Note that the above example is provided for illustrative purposes only and is not meant to be limiting in any manner.

5.1 No agreement specifying a **minimum** taught by prior art

Shults teaches a "medical cost-containment system for ensuring that the anticipated cost savings from utilization review (UR) agreements are actually realized. The UR agreements are essentially contractual agreements that specify the type and quantity of medical treatments relating to a specific claim resulting from a specific injury." (Abstract). Since the goal of Shults is "cost containment", it is clear upon reading Shults in whole that even though the more general term "quantity" of medical treatments is used in the Abstract, a particular number of "maximum" number of treatments are contemplated as being authorized by a UR agreement. It does not make sense to read a teaching of a "minimum" number of treatments in Shults because that reading is counter to the goal and purpose of the Shults system – to minimize the costs of medical treatment. An agreement that would require a "minimum" number of treatments effectively requires that "at least a minimum number, if not more" of the treatments are to be provided. Shults teaches away from such a feature by explicitly, throughout the patent, teaching that a "maximum" number of treatments can be authorized (i.e., no more treatments will

be paid for by the payor). Note that this does not mean that a doctor cannot provide more than the maximum number of authorized treatments – just that the payor will not reimburse the doctor for more than the maximum number of treatments. So, as is discussed in more detail below, Shults does not even teach an agreement with a doctor where the doctor agrees to provide anything, not a maximum number of treatments and certainly not a minimum number of diagnoses.

As noted above, there is no commitment on the part of a doctor in Shults to provide even a single treatment, much less a diagnosis. There is certainly no commitment on the part of a doctor in Shults to provide more than one treatment or diagnoses, much less a minimum number of either. In other words, even though a payor authorizes a particular or maximum number of treatments, a particular doctor or doctors do not have to provide each or any of those treatments. The doctor's compensation is not dependent on providing each or all of the authorized or maximum number of treatments. The doctor simply gets compensated for each particular treatment if it is an authorized treatment. Further, there is no teaching or suggestion in Shults that the payor ever checks to determine whether each of the authorized treatments have been provided as a condition for providing any payment. The payor is only concerned that the maximum number of treatments authorized not be exceeded. In fact, having less than the maximum authorized number of treatments would actually benefit the payor since the payor then pays less than the maximum authorized amount. In other words, Shults teaches away from a minimum number of treatments because of its goal of reducing the payments to be made by the payor. Requiring a minimum number of treatments would encourage additional treatments, which is exactly what Shults seeks to avoid.

Applicants gratefully acknowledge Examiner's statement that Mayaud does not teach establishing an agreement with an expert as claimed in claims 34, 50, and 51. Mayaud teaches an "electronic prescription creation system for physician use." (abstract). A physician who has diagnosed a patient may access the prior medical history of a patient and information about possible medications to prescribe, as an aid to the physician in selecting the appropriate treatment for the patient. There is no teaching or suggestion in the prescription creation system of Mayaud of a physician agreeing to provide a minimum number of diagnoses, or even a minimum number of treatments.

5.2 Doctor does not agree to provide treatment or diagnosis in prior art

In the UR agreements taught by Shults, a doctor does not agree to provide a particular quantity or maximum number of the authorized treatments. There is no commitment on the doctor's part to provide any treatment. In the UR agreements of Shults, a medical service payor, such as an insurance company, agrees to pay for a maximum number or particular number of treatments authorized by the payor. While the payor may be committed to pay for up to the maximum number of treatments authorized, the doctor is not committed to provide such treatments based on the agreement. If the doctor does provide a treatment in Shults and that treatment is an authorized treatment and does not exceed to maximum amount of treatments, the doctor is paid by the payor for providing the treatment. In contrast, in embodiments of Applicants' invention claimed in claims 34, 50, and 51, the doctor agrees to provide a minimum

number of diagnoses and receives the compensation amount specified by the agreement if he provides the agreed upon minimum number of diagnoses.

Similarly, in Mayaud a doctor never enters into an agreement to provide a diagnosis, much less a minimum number of diagnoses during a period of time.

5.3 Electronically transmitting requests for diagnoses not taught by prior art

Applicants respectfully disagree with Examiner's assertion that Mayaud teaches (i) transmitting, during a time period, a plurality of requests to an expert, wherein each request comprises a request for a diagnosis of a physical anomaly associated with a patient; or (ii) receiving, from the expert, a response to each of the requests, the response to each request being a diagnosis for the patient of the request (pg.6, ¶ 20 of paper no. 6). Applicants note that Examiner helpfully clarified this assertion during the personal interview of March 31 as referring to a patient's request for a diagnosis from a physician when the patient visits the doctor in Mayaud. To overcome this interpretation of Mayoud, Applicants have amended claims 34, 50, and 51 to make explicit what was inherent in the claims: that the transmitting of the plurality of requests is done electronically. In embodiments of Applicants' invention, an expert is contacted by the system of the claimed invention when a physical anomaly is detected in a patient and a diagnosis is requested from the expert. Such a feature is not taught or suggested by either Mayaud or Shults, alone or in combination.

Applicants also note that Examiners expressed concern, during the personal interview of March 31, that Fig. 15 references, in element 1590, a requested service and that this feature may anticipate applicants claimed feature of "transmitting a request for a diagnosis". Upon reviewing the detailed description of Fig. 15, Applicants respectfully submit that the requested service in area 1590 of Fig. 15 is a service (*i.e.*, treatment for a diagnosed injury of a claimant) that a doctor requests be authorized by a payor. In other words, the treatment entered into field 1502 of area 1590 is a treatment that the doctor desires to provide to the claimant and is requesting reimbursement from the payor. Looking at other portions of Fig. 15, the detailed description goes on to explain that the payor may then counter with a recommended service/treatment (field 1520 of area 1591) and after negotiations between the doctor and the payor, an expected service/treatment (field 1531 of area 1592) is agreed upon. The purpose of the record illustrated in Fig. 15 appears to be to track the negotiating process of a UR agreement between the payor and the doctor for a treatment of a particular injury of a claimant. Accordingly, the Fig. 15 does not anticipate Applicants' claimed step of:

- transmitting, electronically and during the time period, a plurality of requests *to the expert*, wherein each request comprises a request for a diagnosis of a physiological anomaly associated with a patient

In Shults the doctor, after diagnosing the patient, requests authorization of treatment from the patient's insurance company. No entity in Shults electronically transmits a request for a diagnosis of a physical anomaly *to an expert*.

Similarly, in Mayaud a patient may visit a doctor to obtain a diagnosis and the doctor may use the prescription creation system to select a treatment for the patient but there is no teaching or suggestion of any entity electronically transmitting a request for a diagnosis.

5.4 No agreement by expert to provide diagnoses taught by prior art

Neither Mayaud nor Shults teaches or suggests an agreement with an expert (e.g., a doctor) under which the expert agrees to provide a minimum number of *diagnoses* during a time period.

Shults teaches UR agreements. UR is defined by Shults as “the process whereby a pre-treatment agreement, which outlines the nature and quantity of the authorized medical treatments, is negotiated between the provider and the payor.” (col. 1, lines 50 – 53). In the Summary of the Invention, Shults states that “[e]ach UR agreement comprises a claim number, a procedure code describing the particular medical service authorized, and some indication as to dates or quantity of service authorized.” Thus, taking the two passages together, it is clear that the “medical service authorized” discussed in the Summary are “authorized medical treatments”. Upon reading the Shults reference as a whole, a person of ordinary skill in the art would not understand the term “authorized medical services” to be anything but treatments for a specific injury.

Applicants note the concern of Examiners, expressed during the personal interview of March 31, that the term “medical services” may be read broadly to encompass “diagnosis”. However, Applicants respectfully note that a printed publication prior art reference is prior art only for what it enables, as would be understood by a person of ordinary skill upon reading the reference. (*In Re Donahue*, 766 F.2d 531, 226 USPQ 619, 621 (Fed. Cir. 1985)). Based on the disclosure of Shults as a whole, there is no teaching or suggestion that the medical services authorized in Shults are anything but medical treatments and certainly not diagnoses.

Applicants note that Examiners expressed concern regarding Fig. 6 of Shults and the presence of multiple fields named “diagnosis” in the table of that Figure. Upon reviewing the Fig. 6 and the detailed description thereof, Applicants respectfully submit that it is clear that the table is a record for a particular claimant or patient insured by the payor (see, for example, fields 604 and 606). A particular claimant insured by an insurance company may be diagnosed more than once for various injuries or even for the same injury. The fields in the table of Fig. 6 provide a place for information regarding different diagnoses for a particular claimant. However, there is still no teaching or suggestion in Shults of an expert (e.g., a doctor) agreeing to provide a minimum number of diagnoses in exchange for a compensation amount. The description of Fig. 6 does not teach whether the various diagnoses of a claimant are provided by different doctors or the same doctor. Irrespective of which interpretation is adopted, the description of this Fig., even when taken together with the remainder of Shults and / or with Mayaud, does not teach or suggest an agreement by an expert to provide a minimum number of diagnoses in exchange for a compensation amount.

5.5 No periodic compensation to expert taught by prior art

Neither Mayaud nor Shults, alone or in combination, teach or suggest providing a periodic compensation to a doctor or another type of expert. Shults teaches providing payment from the payor to the doctor for a treatment provided by the doctor, if the treatment was authorized in a UR agreement. However, the doctor is paid upon providing the treatment and not on a periodic basis. Mayaud is entirely devoid of any teaching or suggestion of how or when a doctor may be compensated.

5.6 Dependent Claims 35 – 41

Claims 35 – 41 are each respectively dependent from independent claim 34 and thus include each respectively include each of the limitations of claim 34. Accordingly, Applicants respectfully submit that claims 35 – 41 are patentable at least for the same reasons discussed with respect to claim 34.

5.7 No proper motivation to combine the references as suggested

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992). It is the burden of the Examiner to establish a *prima facie* case of obviousness by pointing to a specific teaching in the record that would have motivated one of ordinary skill in the art to modify the prior art in the manner suggested by Examiner. *In re Fine*, at 1598. Applicants respectfully submit that Examiner has not met this *prima facie* burden for the pending claims because Examiner has not pointed to a specific teaching or suggestion *in the prior art* but has merely provided an unsupported conclusory statement.

Examiner's statement that it would have been obvious to modify the prior art to "incorporate the billing and payment scheme of Shults et al. into the system of Mayaud based on the tracking of diagnoses performed by physicians" for the purpose of "saving patients money on medical costs by providing negotiating power over medical procedures" are not sufficient to meet the Examiner's burden of providing a *prima facie* case of obviousness.

First, there is no identification of a particular teaching in the record (e.g., in the references themselves or particular knowledge in the art) that explains why one of ordinary skill in the art would have been motivated to make the combination suggested by Examiner. Second, Applicants are confused as to how the motivation relates to Applicants' invention. In Applicants' claimed invention there is no negotiation over medical procedures. There is an agreement by an expert (e.g., a doctor) to provide a minimum number of diagnoses in exchange for periodic compensation. Thus, in one example embodiment, a doctor may earn extra salary by

agreeing to provide at least ten diagnoses per month in response to requests for diagnoses received from the system taught in embodiments of the present invention. Applicants are unsure how such a benefit may be realized by the combination of references suggested by Examiner. It does not appear that it can be, in fact, because the suggested combination does not teach or suggest an agreement with an expert wherein the expert agrees to provide a minimum number of diagnoses during a period of time in exchange for periodic compensation.

If Examiner maintains the position that each of the limitations of the pending claims are taught by the prior art, which Applicants submit they are not, Applicants urge Examiner to apply a proper obviousness analysis and point to a specific suggestion in the prior art or within the knowledge of one of ordinary skill in the art that would make the suggested combination/modification of the prior art result in Applicants' claimed invention. A proper obviousness analysis cannot be "limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" (*In Re Dembicza*k, 175 F.3d 994, Fed. Cir. 1999, holding that the Board of Appeals holding of obviousness cannot stand as a matter of law, due to the Board's failure to support its finding of obviousness by a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." (*Id.*).

Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461-7041 or via electronic mail at mfincham@walkerdigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a two-month extension of time with which to respond to the Office Action. Please charge \$205.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

May 7, 2003
Date



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